

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1 and 2 are pending in this application. Claim 1 is amended, without prejudice. No new matter is added by these amendments. Support for this amendment is provided throughout the Specification, and specifically at pages 5 and 7-8. It is submitted that these claims, as originally presented, were in full compliance with the requirements of 35 U.S.C. §112. The amendments and remarks herewith are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, the amendments and remarks are made simply for clarification and to round out the scope of protection to which Applicant is entitled.

II. 35 U.S.C. §103(a) REJECTION

Claims 1 and 2 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,216,016 to Cronin in view of U.S. Patent No. 6,167,251 to Segal et al.

Claim 1, as amended, recites, *inter alia*:

“...play back pre-selected music information stored in said external memory unit and controlling said wireless communication means to transmit the music information as a call holding tone such that the music information is non-repetitive.

wherein the pre-selected music information is used
as a ring tone of the portable wireless communication
apparatus.” (emphasis added)

As understood by Applicant, U.S. Patent No. 6,216,016 to Cronin relates to a portable telecommunications device has a radio transceiver, a keypad, a memory, and a microcontroller for controlling device functions. The portable telecommunications device receives an incoming call from a calling party that calls a called party who is operating the portable telecommunications device. Upon receiving the incoming call, the portable telecommunications device alerts the called party. When the called party presses a key other than the hook key, the portable telecommunications device starts periodic transmission of a waiting message to the calling party while putting the portable telecommunications device on hold. The portable telecommunications device halts the periodic transmission of waiting messages and returns to normal communication mode when the called party initiates such halting.

As understood by Applicant, U.S. Patent No. 6,167,251 to Segal et al. relates to a keyless portable cellular phone system, in which matched sets of algorithmically generated communication units are generated, each communication unit pair defining a discrete time increment of authorized communication. One set is stored on a system server (i.e. a service provider), and the pre-paid set is available for use within a keyless portable cellular phone. The phone, normally non-activated, automatically contacts the system server upon selective activation by the user, to initiate a call (outgoing or incoming). A voice recognition system allows the user to place calls and/or receive calls. The phone typically has either an internal energy supply and storage for pre-paid communication units, or a removable airtime cartridge,

typically containing an energy supply and either the ability to store or to generate a set of pre-paid single use airtime communication units.

Applicant respectfully submits that neither Cronin nor Segal, taken alone or in combination, disclose or suggest the above-identified features of claim 1. Specifically, Applicant submits that the combination fails to teach or suggest communication means to transmit the music information as a call holding tone such that the music information is non-repetitive, wherein the pre-selected music information is used as a ring tone of the portable wireless communication apparatus, as recited in claim 1.

Therefore, Applicant respectfully submits that claim 1 is patentable.

Furthermore, Applicant maintains the position, articulated in the response dated August 24, 2004, that there is no motivation to combine the Cronin and Segal patents.

As stated above, Segal relates to a **keyless** portable cellular phone system, wherein a voice recognition system allows the user to place and receive calls. Segal distinguishes its keyless invention with conventional phones throughout its specification, for example in column 9, lines 43-53.

Cronin, by contrast, relates to what Segal would consider a “conventional” phone. That is, Cronin relates to a portable device having a radio transceiver, a keypad, and a cordless radio base station. Thus, Cronin and Segal teach away from each other, thereby negating any motivation to combine.

The Examiner’s belief that Segal arguably provides for an external memory unit does not negate the inherent deficiencies in the cited documents. It is well settled that picking and choosing portions from disparate references in order to formulate an obviousness rejection is impermissible.

Against this background, none of the cited documents render Applicant's invention unpatentable. As explained above, the documents are disparate, teach away from each other, and would repel a skilled artisan from even considering a combination in order to practice the instantly claimed invention.

Therefore, applying the law to the instant facts, the rejection is fatally defective and should be removed.

Consequently, reconsideration and withdrawal of the Section 103 rejection are believed to be in order and such actions are respectfully requested.

III. DEPENDENT CLAIM

Claim 2 is dependent from claim 1 discussed above and is therefore believed patentable for at least the same reasons. Since claim 2 is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability on its own merits is respectfully requested.


CONCLUSION

In the event the Examiner disagrees with any of statements appearing above with respect to the disclosures in the cited references, it is respectfully requested that the Examiner specifically indicate those portions of the references providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing remarks, it is believed that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

Respectfully submitted,
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